

REMARKS

After entry of the subject amendment, claims 1-15 and 17-51 remain in the application with claims 1, 6, and 30 in independent form. More specifically, claims 1-26, 29, and 47 have been amended, claim 16 has been canceled (via previous amendment), and claims 50-51 have been added in this amendment. There is full support in the specification for the amendments to the claims (see, for example Paragraph [0015]) and for added claims 50-51. Accordingly, no new matter has been added.

Claims 1-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bassett (United States Patent No. 4,139,514) in view of Collins et al. (WO 99/09104). In view of the telephonic interview with Primary Examiner Patrick Niland on September 28, 2004 and in view of the amendments to independent claims 1 and 6, the Applicant respectfully traverses.

The Clearcoat Composition Claims (1-15, 17-29, 47, and 50-51):

In accordance with the telephonic interview, the Applicant has amended independent claims 1 and 6 to further clarify that the claimed clearcoat composition is, more specifically, a *solventborne* clearcoat composition. In other words, the clearcoat composition is not aqueous- or water-based. Also in accordance with this interview, the Applicant respectfully asserts that the solventborne clearcoat composition, now claimed, is further distinguishable from the prior art, especially Bassett. The understanding of the general terminology solventborne, i.e., solvent-based, is readily appreciated by those skilled in the art. Solventborne clearcoat compositions, and other solventborne paint compositions (e.g. primer, base (or top) coat, etc.) are widely known and are readily distinguishable from waterborne compositions.

In prior amendments and remarks, the Applicant has already established support for the claimed amount of water-soluble surfactant (0.15 to 5 parts by weight based on 100 parts by weight of the solventborne clearcoat composition), and has also established that this amount is different from the amounts disclosed and taught in the prior art.

In contrast, although Bassett discloses a clearcoat composition (for instance,

Example 28 of Bassett) that contains dioctyl sodium sulfosuccinate as a surfactant, Bassett does not disclose, teach, or otherwise suggest the claimed solventborne clearcoat composition. Instead, Bassett's Abstract generally indicates a scope of *aqueous, water-borne vehicles*, and with specific reference to Example 28, the *water-soluble* vehicle that is used to formulate the clear *water-soluble* coating composition is based in 1250 grams of water.

Furthermore, relative to Collins et al., it is also apparent that this reference focuses exclusively on *water-based* polymer coating compositions (refer to the Title, the Abstract, the Field of the Invention, the Claims, etc.).

In conjunction with the amendments to the claims and in view of the reasoning set forth above, it is respectfully submitted that Bassett and Collins et al., either independently or in combination, do not disclose, teach, or otherwise suggest independent claims 1 and 6 as amended. To this end, it is believed that claims 1-15, 17-29, 47, and 50-51 are allowable.

The Method Claims (30-46, 48-49):

As also discussed in the interview with the Examiner, the method claims are allowable over the prior art because, as recited in independent claim 30, the claimed method requires that a resin of the clearcoat composition be provided and that a cross-linking agent of the clearcoat composition be incorporated with the resin to first form an intermediate composition. Once this intermediate composition is formed, the method then requires that the water-soluble surfactant be incorporated into the intermediate composition to form the clearcoat composition. That is, the water-soluble surfactant is added to the intermediate composition that already includes the resin and the cross-linking agent. The water-soluble surfactant is not added to the resin during a separate process for producing the resin. As described throughout the original specification, the significance of this method is that it reduces the ability of rain to bead on a film of a clearcoat composition, which improves resistance to etch from acid rain.

On the other hand, Bassett does not disclose, teach, or suggest incorporating the water-soluble surfactant into an intermediate composition that already includes a resin and a cross-linking agent. Instead, Bassett merely discloses the incorporation of a water-soluble surfactant into a resin. That is, Bassett merely discloses utilizing the water-soluble surfactant during the making of the polymer, i.e., the resin. Further, there is no motivation in Bassett to incorporate the water-soluble surfactant after the formation of the resin.

In view of the remarks set forth above relative to the method claims, it is respectfully submitted that the § 103(a) rejection relying on Bassett is overcome and that claims 30-46 and 48-49 are allowable.

It is respectfully submitted that the application is now presented in condition for allowance, which allowance is respectfully solicited.

The Commissioner is authorized to charge Deposit Account No. 08-2789 for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the attached **Amendment, One-Month Extension of Time, fee and return post card** are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the **Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450**, on **October 13, 2004**.

Brenda J. Hughes
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